



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/240,250	01/29/1999	BRIAN BOESCH		7144

22208 7590 01/31/2002

ROBERTS ABOKHAIR & MARDULA  
SUITE 1000  
11800 SUNRISE VALLEY DRIVE  
RESTON, VA 20191

EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

2165

DATE MAILED: 01/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

NH.

# Office Action Summary

Application No.  
09/240,250

Applicant(s)  
Boesch

Examiner  
Cuong H. Nguyen

Art Unit  
2165



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 15, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 20) ☐ Other:

DETAILED ACTION

1. This Office Action is the answer to the IDS received on 3/15/2001, which paper has been placed of record.
2. Claims 1-79 are pending in this application.

*Drawings*

3. This application has been filed with formal drawings, and they are approved as indications by the draftsman.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

- (a) *A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

4. Claims 1-79 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **amazon.com** in view of the Official Notice. After examine pending claims, the examiner submits that the only "arguable" limitation in independent claims describing: sending a message to a server, that server would forward said message comprising a computer address, then "automatically" access that address. There is nothing "incredible" for this action (the only feature that the examiner would consider to be the main idea for

09/240,250  
Art Unit 2165

this application) because instead of putting a computer address in an email, user can type in "GO TO" block to access that same address OR the same method has been INHERENTLY DONE by a server. Claims' limitations have been widely used in Internet accessing (specifically amazon.com 's applications), and those Internet widely used features are very convenient for the users because it directly let the user immediately access wanted computer's sites. (Another example is a server let user access to its site, then inside the server there are address that matches the user's need, then the user only need to "click" to activate said wanted computer address). Moreover, 35 USC 103(a) rejections are proper for using submitted IDS to reject pending claims 1-79 with that very broad claimed languages; **those references determine that what the applicant is seeking to claim is not novel** (In re Abele, 684 F.2d at 907, 214 USPQ at 687 and Accord, e.g., Arrhythmia Research Tech. V. Corazonix Corp., 958 F.2d 1053, 1059, 22 USPQ2d 1033, 1038 (Fed. Cir. 1992).

According to claims' structure, there are 3 separate components: consumer's computer, information server, and merchant's computer. These components are connected by networks (well-known), and exchanging information (emails, messages .etc.); the examiner submits that there is nothing novel of deriving this configuration.

*Conclusion*

5. Claims 1-79 are not patentable.

6. The following references (US. Patents & articles about are cited:

- US Pat. 6,092,053 - 7/18/2000 System and method for merchant invoked electronic commerce.
- US Pat. 5,668,953 9/16/1997 Method and apparatus for handling a complaint.
- US Pat. 6,002,767 - 12/14/1999 System and method , and article of manufacture for a modular gateway.
- US Pat. 5,950,173 - 9/07/1999 System and method for delivering consumer product related information to consumers within retail environments using Internet-based information servers and sales agents.
- US Pat. 5,903,652 - 5/11/1999 System and apparatus for monitoring secure information in a computer network.
- US Pat. 5,864,604 - 1/26/1999 Method of providing message service for limited access telecommunications.
- US Pat. 5,815,665 - 9/29/1998 System and method for providing trusted brokering services over a distributed network.

09/240,250  
Art Unit 2165

- US Pat. 5,793,972 8/11/1998 System and method for providing an interactive response to direct mail by creating personalized web page based on URL provided on mail piece.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:15 AM-3:15 PM.

**Any response to this action should be mailed to:**

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

**or faxed to:** (703) 746-7239 (Official)

Or: (703) 746-5572/746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., 4<sup>th</sup>. Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

*Cuong H. Nguyen*  
Primary Examiner  
January 12, 2002